

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PETER M. BONUTTI

Appeal No. 1999-0925
Application No. 08/735,916

HEARD: October 26, 2000

Before CALVERT, FRANKFORT, and JENNIFER D. BAHR,
Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 28 to 31, 33, 35, 36 and 38 to 40. Of the other claims remaining in the application, 21 and 22 stand withdrawn from consideration

Appeal No. 1999-0925
Application No. 08/735,916

under 37 CFR § 1.142(b) as being directed to a nonelected invention,¹ and claims 41 to 43 have been allowed.

¹ Although appellant states on page 2 of the brief that these claims have been cancelled, no amendment cancelling claims 21 and 22 is found in the file.

Appeal No. 1999-0925
Application No. 08/735,916

The claims on appeal are drawn to an implant apparatus,
and are reproduced in Appendix A of appellant's brief.

The references applied in the final rejection are:

Walker 1973	3,774,244	Nov. 27,
Hodorek 1990	4,979,957	Dec. 25,
Mikhail 1995	5,383,937	Jan. 24,

(filed Feb. 26, 1993)

The claims stand finally rejected on the following
grounds:

- (1) Claims 28 to 31, 33, 35, 36, and 38 to 40, unpatentable
for failure to comply with 35 U.S.C. § 112, second paragraph.
- (2) Claims 28 to 31, 33, 35, 39 and 40, anticipated by Mikhail
or Hodorek, under 35 U.S.C. § 102(b).
- (3) Claims 36 and 38, anticipated by Walker, under 35 U.S.C.
§ 102(b).

Rejection (1)

The examiner asserts that the rejected claims are
indefinite because (answer, pages 4 and 5):

These claims are directed to an apparatus
which comprise [sic] the combination of an
implant and a plurality of spaced apart cement
bodies. Examiner maintained that the apparatus
as claimed does not exist except in vivo. The

Appeal No. 1999-0925
Application No. 08/735,916

apparatus does not exist in the market place since the cement bodies only are present after the implant has been placed into the patient and the cement, after a predetermined time, has cured into a pluralities [sic] of discreet [sic: discrete] bodies.^[2]

The examiner further states (id., page 6):

As argued previously, the "cement bodies" as claimed do not exist until the device has been implanted and the connection to the patient is permanent. If we choose to allow appellant's coverage to include the cement body [sic: bodies] then appellant will also have to positively claim the patient, since the bodies only exist as an entity between the recesses formed in the implant and the bone of the patient. Appellant is prohibited in claiming the combination of the implant and the body under 35 U.S.C.[§] 101.

We do not consider this rejection to be well taken. The test for compliance with the second paragraph of § 112 is "whether a claim reasonably apprises those of skill in the art of its scope," In re Warmerdam, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994), and we have no doubt that one of ordinary skill would have no difficulty in understanding the scope of the instant claims. The second paragraph of § 112

² Since allowed claims 41 to 43 also recite the bodies of cement, it is not apparent why they were not included in this rejection.

Appeal No. 1999-0925
Application No. 08/735,916

provides that the claims shall claim "the subject matter which the applicant regards as his invention," and we are aware of no authority to the effect that the claims are indefinite unless the claimed subject matter is limited to what will be sold in the market place, as the examiner apparently believes. Compare In re Breslow, 616 F.2d 516, 519, 205 USPQ 221, 225 (CCPA 1980) (permissible to claim a transitory compound which is unstable and cannot be isolated).

The examiner's real concern seems to be that the claims are drawn to subject matter which is nonstatutory under 35 U.S.C.

§ 101, because it includes, or "will have to positively claim [, part of] the patient," namely, the bone.³ However, assuming that the inclusion of bone in the claimed combination would violate § 101, there would be no violation here because the bone is not so claimed, nor is it apparent why it would

³ This position is evidently based on the Commissioner's Notice of April 7, 1987 (1077 O.G. 24 (Apr. 21, 1987)), which stated that "A claim directed to or including within its scope a human being will not be considered patentable subject matter under 35 U.S.C. § 101."

have to be. Rather, the claims recite a plurality of bodies of cement each of which has an end portion with "surface means for engaging one of the recesses in the bone," or "for engagement with a recess [or cylindrical recess] in the bone in the patient's body"; they do not claim the bone per se as an element of the apparatus.

The examiner also considers claim 30 to be indefinite because it does not further limit the apparatus. However, claim 30 is more specific than claim 28, from which it ultimately depends, since it recites that the recesses in the implant and the bone have the same configuration, whereas parent claim 28 only recites that they have configurations which correspond. Therefore, we consider that claim 30 does further limit its parent claim(s), as required by § 112, fourth paragraph, and is not indefinite.

Accordingly, rejection (1) will not be sustained.

Rejection (2)

In view of his position with respect to the § 112 rejection, supra, the examiner states that he "has interpreted the 'apparatus' limitation as being directed to an implant and a cement source" (answer, pages 9, 10 and 11). Consequently,

in applying the prior art, the examiner appears to have disregarded the cement bodies as recited in the claims, but such an approach is incorrect, for as stated in In re Glass, 472 F.2d 1388, 1392, 176 USPQ 489, 491 (CCPA 1973), "[i]t is error to ignore specific limitations distinguishing over the references." See also In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)(a term in a claim cannot be ignored because it is indefinite).

Turning to the Mikhail and Hodorek references, while each does disclose an implant which is cemented to bone and contains recesses (e.g., Mikhail at 166, Hodorek at 22), neither discloses a plurality of bodies of cement as called for by independent claims 28, 39 and 40. Thus, in Mikhail there is only one recess 28, 32 in the bone, not a plurality. Hodorek does not disclose whether any recesses are formed in the bone, and even though posts 16 would presumably be located in one or more recesses, it would be merely speculative as to what form such recess(es) would take.⁴ Moreover, the configurations of the recesses in the bone and in the implant

⁴ Appellant asserts that the posts would all be located in one recess, as shown in Exhibit B of his brief.

(recesses 22) would not correspond, to form a plurality of bodies of cement as claimed. Since neither Mikhail or Hodorek discloses all the limitations of the rejected claims, expressly or inherently, they do not anticipate.

Rejection (2) will not be sustained.

Rejection (3)

Walker discloses an implant 50 which is cemented to a bone 15 and has recesses 58, 59 in its lower surface. Also, in the bone surface facing the implant are cement-filled holes (recesses) 60.

Considering Walker's disclosure in relation to independent claim 36, the two recesses (grooves) 59 in Walker's implant 50 may be said to be "spaced apart" as recited, and the cement bodies in recesses (holes) 60 in the bone may be said to have "a first end portion with surface means for engaging one of the recesses in the bone" and "a second end portion disposed in one of said recesses of said plurality of recesses in said implant," as claimed. Nevertheless, we do not consider that Walker anticipates claim 36 because in Walker the bodies of cement are not "spaced apart bodies of cement," as required by the claim, but rather

Appeal No. 1999-0925
Application No. 08/735,916

the cement in the two recesses 60 in the bone, and in the recesses 58, 59 in the implant, all forms one single mass of cement (as shown in Figs. 1 and 2). In other words, since the second end portions of Walker's cement bodies are joined together, they do not meet the claimed requirement that the cement bodies be "spaced apart."

We therefore will not sustain the rejection of claim 36, or of claim 38, dependent thereon.

Conclusion

The examiner's decision to reject claims 28 to 31, 33, 35, 36 and 38 to 40 is reversed.

REVERSED

IAN A. CALVERT)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES

Appeal No. 1999-0925
Application No. 08/735,916

JENNIFER D. BAHR)
Administrative Patent Judge)

SLD

Appeal No. 1999-0925
Application No. 08/735,916

CALVIN G. COVELL
1111 LEADER BUILDING
CLEVELAND, OH 44114-1400

Shereece

Appeal No. 1999-0925
Application No. 08/735,916

APJ CULVERT

APJ

APJ KEYBOARD()

REVERSED

Prepared: June 9, 2001